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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,254	02/05/2007	Susumu Yamaguchi	4600-0120PUS1	6745

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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WILLIAMS, LELA S

ART UNIT	PAPER NUMBER
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4132

NOTIFICATION DATE	DELIVERY MODE
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07/27/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,254	<b>Applicant(s)</b> YAMAGUCHI ET AL.	
	<b>Examiner</b> LELA S. WILLIAMS	<b>Art Unit</b> 4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date  | 6) <input type="checkbox"/> Other: _____                          |

5/4/2006, 9/19/2006, 08/03/2007, 06/04/2008, 10/29/2008, 11/13/2008, 12/05/2008.



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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims (1-10, and 24), drawn to a body taste improver comprising a long-chain highly unsaturated fatty acid and/or an ester thereof as a main component and a body taste-increasing component.

Group II, claim(s) 11-23, drawn to a vegetable oil composition.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity does not exist between Groups I and II. The special technical feature common to all the claims is the long-chain highly unsaturated fatty acid and/or an ester. However, since the use of long-chain highly unsaturated fatty acids and/or esters is known in the art to improve the quality of food and is shown to do so in JP 2001-226693 ( abstract).

3. During a telephone conversation with Susan Gorman on July 7, 2009 a provisional election was made with traverse to prosecute the invention of Group II claims 11-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-10 and 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugiura et. al. (U. S. Pat. No. 6,361,980) as further explained by *Chemical and Stability Characteristics of Structured Lipids from Borage (Borago officinalis L.) and Evening Primrose (Oenothera biennis L.) Oils*, hereafter Shahidi.

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Regarding claims 11-13, Sugiura et. al. discloses a process for preparation of diglycerides in which it is shown that the preferred fatty is arachidonic acid derived from vegetable oils which include borage oil (col. 5, line 10-16).

Regarding claim 14, the fat and oil composition of Sugiura et. al. would inherently have an  $\alpha$ -linolenic content of less than 5% since it is made with borage oil which has a composition of  $0.21 \pm 0.05$  %, as shown by Shahidi.

Regarding claim 15, the fat and oil composition of Sugiura et. al. teaches oleic acid in the amount of 11.6% - 86% in Table 1.

8. Claims 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Higashiyama et. al. (EP 0956774).

Regarding claim 16, Higashiyama et. al. teaches an oil composition comprising a long-chain highly unsaturated fatty acid, with an  $\alpha$ -linolenic content is less than 5% (page 3, line 31)

Regarding claim 17, Higashiyama et. al. teaches an oil composition which comprise 1-5%  $\gamma$ -linolenic acid (page 3, line 31).

Regarding claim 18, Higashiyama et. al. teaches an oil composition with linoleic acid content of 5-15% (page 3, line 30).

Regarding claims 19-21, Higashiyama et. al. teaches an oil composition which contains arachidonic acid originating in microorganisms (page 3, line 11).

Regarding claim 22, Higashiyama et. al. teaches a food having the vegetable fat and oil composition of a long chain highly unsaturated fatty acid, with an  $\alpha$ -linolenic content is less than 5% (abstract).

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Regarding claim 23, Higashiyama et. al. teaches a method for improving body taste of a food, by adding the body taste improver of the vegetable fat and oil composition to the food (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike LaVilla can be reached on 571-272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LELA S. WILLIAMS/  
Examiner, Art Unit 4132

/Milton I. Cano/  
Supervisory Patent Examiner, Art Unit 4132